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EXAMINER

DATSKOVSKIY, SERGEY

ART UNIT PAPER NUMBER

2121

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/931,362

Applicant(s)

DAN ET AL.

Examiner

Sergey Datskovskiy

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Status of the claims**

Claims 1-18 were originally presented. After the Non-final Office Action, claims 1, 5, 6, 8, 10, 11, 13, and 18 were amended. Claims 1-18 are still pending in the Instant Application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4, 6-7, 9 and 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ng (US Patent No. 5,971,855).

### **Claim 1**

Ng teaches a toy learning apparatus using a cyber community (Abstract, cyber community is disclosed as "other game users connected to the website")

a cyber community having a cyber character which grows by learning online (col. 2, lines 47-56) and saves experience information according to the learning (col. 5, lines 52-60); and

a toy that grows by receiving one of a cyber character's experience and a user's learning experience (col. 4, lines 10-19, disclosed as a hand-held electronic game apparatus that contains a virtual pet).

**Claim 2**

Ng teaches the apparatus of claim 1, wherein the cyber community is performed in a network server that provides cyber character information of a first user and cyber character information of second user (col. 4, lines 4-7).

**Claim 3**

Ng teaches the apparatus of claim 1, wherein the cyber community is performed in a performance apparatus for outputting the information of the cyber character (col. 3, lines 46-55, performance apparatus is disclosed as a computer).

**Claim 4**

Ng teaches the apparatus of claim 1, wherein the cyber community is performed in a network server supplying operational data for the toy (col. 3, line 64 through col. 4, line 9) and a performance apparatus providing an upgrade program from the network server (col. 3, lines 56-63).

**Claim 6**

Ng teaches the apparatus of claim 2 wherein the network server is characterized in that programs for synchronizing the cyber community are provided to respective users for contacting cyber characters of other users (col. 4, lines 4-7).

#### **Claim 7**

Ng teaches the apparatus of claim 1, wherein the cyber character comprises a first cyber character that exists only in a cyber community and a second cyber character of a user that represents the toy in the real world (col. 4, lines 4-6, "*The Website can simulate another character (new or old) to interact (or fight) with the user's character.*").

#### **Claim 9**

Ng teaches the apparatus of claim 1, wherein the toy exhibits one of motion (col. 6, lines 31-33) and an audio output (col. 6, lines 20-22) and wherein the motion and audio output correspond to one of the experience of the cyber character in the cyber community (col. 3, lines 32-33) and learning by the user (col. 7, lines 6-8).

#### **Claim 11**

Ng teaches the apparatus of claim 1, wherein the toy further comprises memory for information (4, lines 40-45) and an input/output unit for exchanging information with other toys (col. 4, lines 45-47).

#### **Claim 12**

Ng teaches the apparatus of claim 11, wherein the memory of the toy is detachable and can be replaced; by another user's memory (col. 1, lines 9-13, replacing game cartridges).

### **Claim 13**

Ng teaches a learning method for a toy using a cyber community (Abstract), the method comprising:

having the toy obtains first experience information by one of controlling a certain part of the toy (col. 5, lines 13-16, keyboard commands), controlling a remote controller and using information input means (col. 5, lines 11-13);

storing the first experience information in a memory (col. 4, lines 40-45);

having the activity of the cyber character in the cyber community reflect the first experience information by transmitting the experience information to a network server (col. 3, line 64 through col. 4, line 9);

having the toy learn by transmitting from the network server to the toy, second experience information according to the activity of the cyber character in the cyber community (col. 4, lines 3-7, disclosed by Website performing interaction/fighting between characters); and

upgrading an operating/application program according to the extent of learning of the toy according to the second experience information (col. 7, line 66 through col. 8, line 21, modifying character stats based on the result of a fight).

#### **Claim 14**

Ng teaches the method of claim 13, wherein a performance apparatus is used to operate the cyber community by downloading a program for operating the cyber community and data information from the network server to reduce the amount of data which is transmitted between the network server and the performance unit (col. 8, lines 31-44, installing a separate software on a personal computer).

#### **Claim 15**

Ng teaches the method of claim 14, comprising:

reflecting information comprising at least one of a learning result (col. 5, lines 52-60, "training score"), a characteristic (col. 5, lines 66-67), a state of feeling (col. 5, lines 52-53, health) and a degree of growth/intelligence (col. 6, lines 9-10 disclose age; col. 5, lines 66-67 disclose willpower) on the activity of the cyber character which represents the toy in the cyber community (col. 5, line 67 through col. 6, line 8, stats determine the outcome of a fight); and

reflecting the experience information on the activity of the toy by transmitting the experience information to the toy (col. 4, lines 1-9).

#### **Claim 16**

Ng teaches the method of claim 15, further comprising updating the operating/application program according to the extent of learning of the toy (col. 3, lines 64-67, enabling hidden features).

### **Claim 17**

Ng teaches the method of claim 13, wherein the memory of the toy comprises a plurality of memories and wherein the memories allow the toy to have different experiences by replacing at least one of the plurality of memories (col. 4, lines 37-45, device contains two memories, toy's experiences will change when the second erasable memory is replaced (specifically, conditions of the Pet), replacing the first memory will change the predetermined program, thus, also changing the experiences of a toy; see also col. 1, lines 9-13 disclosing the use of game cartridges).

2. Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Matsuda et al. (US Patent No. 6,405,249).

### **Claim 18**

Matsuda teaches a method implemented in a toy (col. 23, lines 50-52, a toy is disclosed as a computer implemented virtual pet), the method comprising:

turning on the power supply of the toy (it is inherent for a computer to have a power supply);

selecting a user of the toy (col. 33, lines 56-65, receiving an identification);

selecting a default user if a user is not selected (col. 33, line 65 through col. 34, line 7, using predetermined information if no identification is provided);



reflecting experience information of the toy on a cyber character in a cyber community according to the selected user (col. 24, lines 45-53) and changing the activity of the cyber community according to the experience information and the selected user (col. 23, lines 40-49, 53-57); and

reflecting the experience of the cyber character in the online cyber community on a current status of the toy by changing an action of the toy according to the experience of the cyber character (col. 25, lines 1-13).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US Patent No. 5,971,855) in view of Bushmitch et al. (US Patent No. 6,494,762).

#### **Claim 8**

Ng teaches the apparatus of claim 3, wherein the performance apparatus has wire communication functions and is one of a computer, a mobile phone and a PDA (col. 3, lines 46-50).

Ng does not expressly teach the performance apparatus having wireless communication functions and is one of a computer, a mobile phone and a PDA.

However, Bushmitch teaches the performance apparatus having wireless communication functions and is one of a computer, a mobile phone and a PDA (col. 3, lines 19-26).

Ng and Bushmitch are analogous art since they are both directed to portable electronic game devices. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the virtual pet toy apparatus from Ng (col. 4, lines 10-19) and combine it with PDA from Bushmitch (col. 3, lines 19-26). The reason for doing so would be for the user to be able to connect to one or more subscription services (Bushmitch, col. 2, lines 22-23), and not getting bored from playing the same game all the time (Bushmitch, col. 1, lines 35-39). Therefore, it would have been obvious to modify Ng in view of Bushmitch by combining a virtual pet toy apparatus with a PDA.

#### **Claim 10**

Ng teaches the apparatus of claim 1, wherein the toy comprises:

a sensor for sensing an outside pulsation comprising at least one of voice, audio, light and contact (col. 5, lines 11-12, disclosed as a microphone);

an input apparatus for inputting one of an image, audio information and letters (col. 4, lines 31-36, keyboard and microphone); and

a communication apparatus for wire communication (col. 3, lines 46-50).

Ng does not expressly teach a communication apparatus for wireless communication.

However, Bushmitch teaches a communication apparatus for wireless communication (col. 3, lines 19-26).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the virtual pet toy apparatus from Ng (col. 4, lines 10-19) and combine it with PDA from Bushmitch (col. 3, lines 19-26) using the same motivation as in claim 8 above.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US Patent No. 5,971,855) in view of Creatures (computer game review published in [http://www.avault.com/reviews/review\\_temp.asp?game=creatur](http://www.avault.com/reviews/review_temp.asp?game=creatur) on July 16, 1997), and farther in view of Bushmitch et al. (US Patent No. 6,494,762)

#### **Claim 5**

Ng teaches the apparatus of claim 1, wherein the cyber community comprises:  
a robot education center for one of upgrading a cyber character program and downloading operation data (col. 3, lines 56-63).

Ng does not expressly teach that the cyber community comprises:  
a home (family) for rearing a cyber character;  
a school in which the cyber character learns audio information comprising at least one of music, voice, motion and gesture; and  
an information center for providing data comprising at least one of a shopping mall, news and weather and wherein the cyber character acts as a shopping guide.

Creatures teach:

a home (family) for rearing a cyber character (page 2, screenshots; page 1, paragraph 3, describing some of the game's rearing scenes such as a Hatchery);

a school in which the cyber character learns audio information comprising at least one of music, voice, motion and gesture (page 1, paragraph 4, teaching the creature some actions and language).

Bushmitch teaches an information center (col. 3, lines 38-44, global information network) for providing data comprising at least one of a shopping mall, news and weather (col. 1, lines 58-65) and wherein the cyber character acts as a shopping guide (col. 8, lines 6-16, shopping is disclosed by selecting and paying for applications and services).

Ng, Creatures and Bushmitch are analogous art since they are all directed to games simulating virtual creatures. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the virtual pet toy apparatus from Ng (col. 4, lines 10-19), combine it with the rearing environment and creature education from Creatures (page 1, paragraphs 3-4) and a global information network connection from Bushmitch (col. 1, lines 58-65, col. 8, lines 6-16). The reason for doing so would be for the user to get bored from playing the same game all the time (Bushmitch, col. 1, lines 35-39), and to supply the game with additional simulated experiences (Creatures, page 1, paragraph 2). Therefore, it would have been obvious

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to modify Ng in view of Creatures, and further in view of Bushmitch by combining a virtual pet toy apparatus with rearing environment having a creature education facility, and a global information network.

### ***Response to Arguments***

Applicant's arguments filed on July 28, 2006 have been fully considered but they are not persuasive. The unpersuasive arguments made by Applicant are stated below:

In reference to Applicant's argument:

It is respectfully submitted that the Examiner has not identified any toy that is disclosed by Ng as learning. It is further respectfully submitted that the connection of "other game users" to "the website" and "download upgrades to the preprogrammed game" disclosed in Ng does not enable any toy to learn, but rather facilitates "interactive play" between users and the modification of a computer game played in cyberspace.

Examiner's response:

Ng discloses that the toy can learn online in col. 2, lines 53-56: "...*the computer at the Website can restore a pet's health, change the pet's age and weight and even perform some training (or behavior modification).*"

Further arguments presented by Applicant are based on the statement that the "virtual pet" of Ng is not analogous to the "cyber character" and the "toy" of current application. For example, Applicant argues that the "cyber character" exists online and the "toy" is limited to exist offline.

To clarify Examiner's position let us start by giving a general definition of "toy". A toy is an object used for playing. According to this definition, the hand-held electronic

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game apparatus of Ng is a toy. However, toys are not limited to physical objects, but can also be represented as software. Support for such interpretation can be found in Wikipedia (<http://en.wikipedia.org/wiki/Toy>, downloaded on September 26, 2006). It defines software toys by saying: "*Most computer games are usually considered to be games, but some are in fact toys as defined by Chris Crawford since they lack clear goals or an explicit end state. Examples include the popular SimCity and its spinoffs, and some other simulation games.*" Therefore, due to the fact that a virtual pet is a *simulation*, it has to be recognized as a toy regardless of being implemented online or offline. Further support to this definition can be found in Applicant's own language used to compose claim 1. Claim 1 discloses "a toy that grows". However, there is no indication of a physical object growing in size or expressing visible signs of aging. In fact, the toy of claim 1 grows by "receiving one of a cyber character's experience and a user's learning experience". That suggests that the claimed toy is primarily defined by the software and not by its physical nature. Furthermore, the toy of Ng is not limited to online existence. Col. 6, line 34 through col. 7, line 40 describe different ways of training the toy offline. Therefore, the toy of Ng can exist both as *offline* and *online* object. Thus, any experience gained by a cyber character directly translates to experience gained by the toy.

The arguments about differences between the virtual pet of Matsuda and the toy of current application are resolved based on definition of "toy" given above, proving that virtual pet is a toy.

In view of these arguments, claims 1 and 13 stay rejected under 35 U.S.C. 102(e) as being anticipated by Ng (US Patent No. 5,971,855), while claim 18 stays rejected under 35 U.S.C. 102(e) as being anticipated by Matsuda et al. (US Patent No. 6,405,249). Dependent claims 2-12 and 14-17 stay rejected due to the unchanged status of the corresponding independent claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sergey Datskovskiy whose telephone number is (571)

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272-8188. The examiner can normally be reached on Monday-Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight, can be reached on (571) 272-3687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.D.

Assistant examiner

A.U. 2121



Anthony Knight

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